

No. 09-56675
IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

JAMES “JIM” BROWN,

Plaintiff and Appellant,

v.

ELECTRONIC ARTS, INC.,

Defendant and Appellee.

On Appeal From The United States District Court
Central District Of California No. 2:09-CV-01598-FMC-RZ
The Honorable Florence-Marie Cooper

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INTRODUCTION

EA hyperbolizes that Brown argues “radical” positions which will “fundamentally alter” and “transform trademark law” while destroying the First Amendment. EA claims that a victory for Brown spells the death of great literary and artistic works — including its own cultural *magnum opus*, the *Madden NFL* football videogame. Brown’s positions, however, are in the mainstream.

Contrary to EA’s portrayal, Brown is neither claiming that the Lanham Act gives him “absolute” control over any and all uses of his persona, nor attempting to “roll back constitutional protections.” (Appellee’s Brief [“AB”]-6.) Brown simply asks that a jury resolve the disputed factual issues he has raised about EA’s unlicensed use of his persona in its videogames. Even under EA’s version of the *Rogers* test, a jury should decide if EA’s unlicensed appropriation was “artistically related” and “explicitly misleading” based on the facts present here, including EA’s incredible denial that it intended Brown to be in the game.

Further, Brown does not ignore this Court’s prior precedents, like *Mattel*, *Walking Mountain*, or *ESS* — those cases simply are not dispositive here. Nor is Brown saying that his case is controlled by *Wendt*, *Waits*, *White*, *Abdul-Jabbar*, and the like — those cases were cited simply to demonstrate that Brown owns a protectable mark in his persona under the Lanham Act, and that use of a celebrity’s persona can mislead the public. Nor does Brown ignore EA’s claim to

First Amendment rights. Rather, Brown's point is that application of the relevant law depends on disputed factual issues that require determination by a jury, under either the *Rogers* balancing test applied by the district court below or other tests this Court has applied in factual settings closer to this case than *Mattel* or *ESS*.

EA posits that the law in this area is crystal clear because this Court has "rejected" its own prior case law, and argues that by merely looking at the videogames, a court can decide that EA's conduct warrants Constitutional protection as a matter of law regardless of the facts. In truth, however, neither the legal nor factual issues are as simple as EA portrays them. Indeed, if it were perfectly legal for EA to use athletes' personas in its games with impunity, why would EA pay millions of dollars in licensing fees to current NFL players to do what it claims the Constitution allows it do for free?

Brown understands the argument that an artist would have a First Amendment right to use his likeness without payment if it were creating an expressive work (like writing a book or making a movie) about Brown. But that's not what EA has done. EA, which prides itself on providing sports videogames extremely realistic in nature, has made a videogame that uses Brown's persona, and allows the person playing the game to simply "do" what Brown did to gain his fame. EA makes no artistic or other comment about Brown (or anything, really), but simply steals Brown's goodwill to sell its profitable product.

To be sure, *some* videogames can be entitled to as much First Amendment protection “as the most profound literature” — especially contemporary games that have complex story lines, fanciful settings, and themes delving into human nature. But that does not mean that *any* videogame is entitled to that level of protection. A simple game of pong is hardly “expressive speech,” as case law affirms.

Although First Amendment law vis-à-vis videogames is still evolving, EA argues that the law has been settled finally and in all cases by pointing to *ESS* and *Rogers*. But as explained in Brown’s opening brief, both are distinguishable for many reasons. The facts present here are closer to those present in other decisions in which this Court applied other tests, and under the standards they articulate, the district court’s dismissal should be reversed.

ARGUMENT

I. FACTUAL DISPUTES REQUIRE REVERSAL OF THE DISTRICT COURT’S DISMISSAL

A. The District Court Made Factual Findings On A Motion To Dismiss

EA’s various arguments that the district court did not make improper factual findings lack merit for the following reasons.

First, EA’s argument that the district court did not make factual findings because it said that it accepted and considered the allegations of the complaint and additional evidence in its opinion (AB-38-39) lacks merit because those facts create disputes that the district court could not properly resolve on a motion to

dismiss. Indeed, the district court’s “acceptance” of those facts — which include, as stated in the complaint (*Cf.* 1:1-ER-5; 2:2-ER-15, 17; 2:3-ER-28, 39-40) the disputed fact about whether Brown is even in the game — strengthens Brown’s argument for reversal. The district court necessarily cherry-picked certain of these “accepted” facts in applying the “balancing” test, and this cherry-picking does not and cannot eliminate EA’s insistence that Brown is not in the game. This position of EA’s bears directly on the judicial determination of artistic relevance, which is simply not ripe for determination at this early stage of the proceedings.

Second, EA’s argument that the district court could disregard Brown’s factual allegations and evidence because it could rely exclusively on the videogames themselves under the “incorporation by reference” doctrine (AB-39) fails. This Court has held in other settings that use of a mark in the title of a work is insufficient to establish that the use is “explicitly misleading” in at least some circumstances, and thus it necessarily is proper to consider additional facts to evaluate that issue. *See Mattel v. MCA Records*, 296 F.3d 894, 901-02 (9th Cir. 2002). Thus, Brown presented evidence within the games, accompanying the games, and in addition to the games that supports the complaint’s allegations that EA’s actions were explicitly misleading. Whether that evidence is persuasive is a question for the jury.

Third, EA’s claim that courts “routinely” dismiss trademark infringement actions on First Amendment grounds (AB-40-41) is contrary to the authorities EA cites: *All* of EA’s key authorities addressed First Amendment issues on summary judgment after the close of discovery.¹ *See Mattel v. MCA, supra; Mattel v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003); *ESS Entm’t 2000 v. Rock Star Videos*, 547 F.3d 1095 (9th Cir. 2008) (all affirming summary judgment on Lanham Act claim in which First Amendment defense alleged).

Further, many courts in factual situations similar to Brown’s — including *ESS*, EA’s principal authority — declined to grant motions to dismiss on First Amendment grounds because of the factually intensive nature of the requisite inquiry. *See ESS Entm’t 2000 v. Rockstar Videos*, 444 F. Supp. 2d 1012, 1016 n.10 (C.D. Cal. 2005) (declining to apply *Rogers* test on motion to dismiss); *Dryer v. NFL*, 689 F. Supp. 2d 1113, 1122 (D. Minn. 2010) (declining to engage in a

¹ *Comedy III Productions v. New Line Cinema*, 200 F.3d 593, 596 (9th Cir. 2000) (cited at AB-39-40) is readily distinguishable because no First Amendment issue was raised in that case. Instead, heirs of the Three Stooges asserted that defendant’s use of a public domain film clip featuring part of an authorized Three Stooges performance supported a Lanham Act claim for use of their personas. This Court dismissed the Lanham Act claim because plaintiff did not show any trademark rights in the particular clip used. *Id.* at 594. The *unauthorized* reproduction of the Three Stooges’ performances was not at issue in that case, which is why this Court did not apply its “unauthorized taking of persona” case law to the facts in that action. *Id.* at 596. *Comedy III* has nothing to do with Brown’s action.

“balancing” analysis on a motion to dismiss because “the Court cannot make a [balancing] determination based solely on the pleadings that the NFL’s use of plaintiffs names and images does not explicitly mislead anyone. This is a fact-intensive inquiry”); *see also*, *Hart v. Electronic Arts*, ___ F. Supp. 2d ___, 2010 WL 3786112, *10 (D.N.J. Sept. 22, 2010) (declining to consider, on a motion to dismiss, First Amendment defense to right of publicity claim brought by NCAA players whose images allegedly appear in EA’s videogames because “[t]ypically, this sort of defense is heard on a motion for summary judgment in light of the intricate facts that the court must consider in divining the nature of the speech”).

Fourth, EA’s argument that ruling on a First Amendment defense on a motion to dismiss is “especially appropriate” because it “is essential to protecting free expression” (AB-39) ignores the fact that two Constitutional principles, rather than one, are at issue here.² Brown’s persona qualifies as a mark under this Circuit’s law, and Brown’s mark is Constitutionally protected intellectual property. (AOB 19-24.) Thus, this case is not simply about EA’s right to “speak”; it is about when and in what circumstances EA can take and use Brown’s intellectual property without permission to increase the profitability of its “speech.” Giving

² Indeed, EA’s string citation to cases that do not involve intellectual property concerns (AB-41-42) underscores EA’s determination to avoid these intellectual property issues. Quotations from such cases add nothing to evaluation of the relevant issues.

due consideration to both constitutional interests supports weighing those issues on a fully developed record, rather than in expedited fashion on a motion to dismiss.

B. Factual Disputes About Whether EA's Use Of Brown's Persona Was "Artistically Related" To EA's Game Should Have Precluded Dismissal Of Brown's Complaint

EA's argument that there is no factual dispute about the "artistically related" nature of its use of Brown's persona lacks merit for several reasons.

First, EA seeks to avoid its own repeated assertions that it did not use Brown's persona in its game. (AOB-25-32.) Artistry is a creative, intentional, volitional act; unintentional uses are merely accidental. Thus, EA could not have had an "artistic purpose" in using Brown's persona in its game if, as it always has maintained, it did not intend to use it. *See Parks v. LaFace Records*, 329 F.3d 437, 452 (6th Cir. 2003) (finding no "artistic relationship" in defendants' use of Park's name in title of song in part because they "never intended for the song to be about Rosa Parks"); *American Dairy Queen Corp. v. New Line Prods.*, 35 F. Supp. 2d 727, 734-35 (D. Minn. 1998) (no "artistic relationship" because defendant admitted in its briefing that it did not intend its "Dairy Queens" title to refer to plaintiff American Dairy Queen Corporation). The district court's assumption of the disputed fact that Brown's image was used — seemingly helpful to Brown on the surface — actually is harmful to Brown because it removes from the case the issue

of artistic relevance created by EA's denials that it used Brown image, which are alleged in the complaint (2:2-ER-15, 17; *cf.* 1:1-ER-5; 2:3-ER-28, 39-40).³

Second, EA's attempt to minimize *Dairy Queen's* recognition of this principle by characterizing it as applying the "widely discredited" alternative means test (AB-24) is both inaccurate and irrelevant. *Parks* found no "artistic relationship" in part because defendants did not intend their song to be about Rosa Parks, even though it rejected the "alternative means" test. *Parks*, 329 F.3d at 452. Further, this Court applied the "alternative means" test in *IOC*, not "discredited" it, and *IOC* was affirmed by the Supreme Court. *See* Section I.C., *infra*.

Finally, *Dairy Queen's* discussion of the "alternative means" test was independent of its "balancing" test discussion. *Dairy Queen* addressed both tests because the Eighth Circuit has done so. *Dairy Queen*, 35 F. Supp. 2d at 734. After finding liability under the "alternative means" test, *Dairy Queen* considered the *Rogers* decision, which invented the balancing test, to evaluate liability under it.

³ EA's related criticism that Brown's complaint did not use the words "artistic relationship" or "expressly misleading" in his amended complaint (AB-42) lacks merit because Brown alleged facts from which a jury could find "no artistic relationship" and "express misleading." Presence or absence of the words themselves does not affect the factual allegations that show those elements to be present here. Indeed, if Brown had added those words, EA doubtless would have argued that the Court need not accept them because they are "legal conclusions." (*See* AB-39.) Brown requests leave to amend his complaint to add those words if the Court believes their addition would be significant.

Id. *Dairy Queen* distinguished *Rogers* because defendant admitted in its briefing — as EA has done — that it did not intend to use plaintiff’s mark, and concluded that defendant’s admission meant that there was no artistic relationship under *Rogers*. *Id.* The logic of that portion of the *Dairy Queen* court’s holding is compelling, and should be followed regardless of this Court’s view of the “alternative means” test discussed in *Dairy Queen*.

Third, EA’s argument that its use of Brown’s persona in *Madden NFL* is “artistically related” as a matter of law because it has “above zero” relevance to football misconstrues what “zero relevance” means in the case law. *Parks* holds that “metaphorical” use of a public figure who refused to get “to the back of the bus” had “zero relevance” to a song lyric in which everyone was invited to get “to the back of the bus.” *Parks*, 329 F.3d at 454. Thus, the fact that EA’s allegedly artistic work involved the same subject matter that made Brown popular is not enough to create “above zero” relevance, especially in light of EA’s incredible denial that it is using Brown’s persona.

Indeed, the *Parks* court’s sensitivity to the need for a true artistic relationship between the use and the work is necessary if the balancing test is to involve anything like true “balancing” — i.e., have some mechanism to weigh the value of what was taken against its importance to the expressive message conveyed. Under EA’s formulation, the “balancing” test inflexibly applies

mechanical rules to achieve predetermined results. EA asks this Court to rule that any conceivable “relationship” between a trademark and a work — no matter how incidental, accidental, or attenuated — means that there is “above zero” relevance that makes the taking automatically and absolutely protected, no matter how valuable the property taken or how unimportant it is to the message being conveyed, unless it is “explicitly misleading” (which, according to EA, it will never be, as described below). EA’s interpretation makes “balancing” a misnomer. There is literally no flexibility, and hence no ability to “balance,” competing interests in such an approach.

C. Factual Disputes About The “Explicitly Misleading” Nature Of EA’s Actions Should Have Precluded Dismissal Of Brown’s Complaint

EA’s argument that there is no factual dispute about the “explicitly misleading” nature of its actions is wishful thinking.

First, Brown submitted more than enough evidence from which a jury could reasonably conclude that EA’s use of his image was “explicitly misleading.” (AOB-25-26, 36-41.) EA’s *Madden NFL* videogame portrays a Cleveland Browns fullback on the “historic” or “classic” 1965 Browns team, with Jim Brown’s jersey number 32 (changed to 47 in post-2003 editions), a player ability rating of 99 (the highest ranking), and Jim Brown’s physical statistics and appearance (e.g., African

American, 6'2", 228 lbs., age 29, right-handed, in his ninth year of NFL play, etc.). (AOB-10.)

Written materials accompanying the game state that both “[f]ifty of the NFL’s greatest players” and all “All-Madden” players are in the game (2:8(F)-ER-227) — and EA does not dispute that Brown is recognized as one of the NFL’s greatest players and is on the “All-Madden All-Millennium” team. (2:8(L)-ER-237.) Nor can EA dispute that the ’65 Cleveland Browns — a “classic” team available in the game — and the All-Browns team — i.e., a composite team of the greatest Browns players in history — must, by definition, include Jim Brown.

The packaging for the 2007 and 2009 versions of *Madden NFL* also displays images of an African American Cleveland Browns player with Jim Brown’s appearance, skin tone and mustache. (Backside of Exhibits F and H, 2:5-ER-112, 114.) This packaging also has the logo of the NFL Players Association (“NFLPA”) and notes “Officially Licensed Product of NFL PLAYERS.” (NFL PLAYERS is the licensing arm of the NFLPA and licenses active and retired NFL player rights.) A jury could easily conclude that this packaging identified Brown — the Cleveland Browns’ most famous player — as a person who was in and endorsed the game.

Second, EA’s objections to Brown’s citations to McCarthy on Trademarks both mischaracterize Brown’s references and seek to avoid their consequences.

Brown never argued that the McCarthy references were evidence “in the record,” as EA argues. (AB-30) Such survey evidence is neither necessary nor appropriate in a motion to dismiss. Brown instead cited McCarthy to show that the best known trademark law treatise recognizes that use of a celebrity’s persona *within* a work, as opposed to merely in the *title* of a work, can create a misleading and inaccurate presumption of permission to an overwhelming majority of consumers. (*See* AOB-24-25, 29-31.) This difference in consumer perception is a basis to differentiate persona uses in titles from those within works, distinguishing this case from *Rogers* and *ESS*. Factual uncertainties concerning the misleading nature of uses of a mark within the body of a work, and the extent to which such use explicitly misleads the public, are precisely why the “explicitly misleading” issue should not have been resolved on a motion to dismiss.

Third, EA misapplies both the Lanham Act’s statute of limitations and accrual rules. (AB-31-32.) This Court has borrowed California’s three-year fraud or four-year trademark infringement limitations periods for California-based Lanham Act claims, rather than the two-year right of publicity limitations period EA advocates. *Jarrow Formulas v. Nutrition Now*, 304 F.3d 829, 837-38 (9th Cir. 2002) (applying California’s three-year fraud statute of limitations to Lanham Act claim because Lanham Act violation rooted in fraud); *Miller v. Glenn Miller*

Prods., 454 F.3d 975, 997 n.11 (9th Cir. 2006) (applying California’s four-year state law trademark infringement period to Lanham Act claim).

Further, this and other courts have held that the applicable limitations period does not accrue until a plaintiff “knows or should have known” of the claim, as opposed to when a “publication” occurs (as EA advocates). *Jarrow Formulas*, 304 F.3d at 838 (“the state limitations period runs from the time the plaintiff knew or should have known about his § 43(a) cause of action”); *Gristede’s Foods v. Unkechuge Nation*, 2008 WL 3334032, *3-4 (E.D.N.Y. 2008) (Lanham Act claim accrued when “plaintiff knew or had reason to know” of its injury).⁴ Brown’s allegations concerning EA’s “scrambling,” public misrepresentations and denials to Brown’s representatives also raise issues of fraudulent concealment and equitable tolling of the applicable statute of limitations that the district court did not address and could not properly be resolved against Brown on a motion to dismiss. *See Socop-Gonzales v. I.N.S.*, 272 F.3d 1176, 1184 (9th Cir. 2001).

⁴ Brown should be able to recover for all injuries that he suffered before he had reason to know of EA’s misconduct (i.e., November 2008, *see* 22-ER-17), including damages incurred beyond the applicable limitations period. *See Polar Bear Prods. v. Timex Corp.*, 384 F.3d 700, 706 (9th Cir. 2004) (in a copyright infringement action, plaintiff could recover damages beyond the three year limitations period because plaintiff did not discover and had no reason to discover the infringement before it did).

EA's contrary arguments that this Court should apply California's two-year right of publicity limitations period and the "single publication rule's" accrual principles should be rejected. The "single publication rule" was created to solve a problem inherent in state defamation law, under which nationwide publication of defamatory material gave rise to 50 different state law claims that required a plaintiff to file 50 different defamation suits to obtain complete relief. *Love v. Associated Newspapers*, 611 F.3d 601, 611-12 (9th Cir. 2010); Prefatory Note to the Uniform Single Publication Act, 14 Uniform Laws Annotated, pp. 469-70 (Thomson/West 2005). The "single publication rule" was developed so that such a plaintiff need bring only one suit to recover nationwide damages. *Id.* To effectuate that purpose, it also generally requires that the limitations period for that suit begins to run from the date of the "single publication," regardless whether a plaintiff knows of it. *Christoff v. Nestle USA*, 47 Cal. 4th 468, 476-81 (2009).

None of these policy concerns apply to Lanham Act claims, which are federal claims that on their face permit recovery of nationwide damages in a single action. Thus, this and other courts hold that Lanham Act claims accrue when a plaintiff "knows or has reason to know" of the claim.⁵ Brown should be able to

⁵ EA's citations to *Spangler v. Abercrombie & Fitch*, 79 Fed. Appx. 325, 326 (9th Cir. 2003), and *Yeager v. Bowlin*, 2008 U.S. Dist. LEXIS 70455, at *3 (E.D. Cal. Aug. 5, 2008) do not support a contrary rule. *Spangler* is an unpublished,

[. . . footnote continued . . .]

recover damages for all harm he suffered from EA's infringement in these circumstances (*see* fn. 4, *supra*), and all of EA's infringing activity is relevant to show liability and damages, whenever it occurred.

Further, evidence of EA's actions in the earlier years would be relevant even if EA's statute of limitations arguments had merit (which they do not). EA's use of Brown's persona in the earlier years, and the way EA subsequently altered this use, illustrates, underscores, and gives context to the explicitly misleading nature of its misconduct in more recent years. It thus is relevant to establish liability even if Brown could not recover damages for it (which he can).

Fourth, EA's argument that the written materials are irrelevant because they would not be seen until after consumers purchased EA's game (AB-33) ignores the risk of post-sale and third party confusion. *See Karl Storz Endoscopy Am., Inc. v. Surgical Techs., Inc.*, 285 F.3d 848, 854 (9th Cir. 2002).

Fifth, EA's argument that its game is protected speech because the written materials are also "protected speech" (AB-33) is circular. According to EA, the game is protected speech because the materials are; and the materials are protected

[. . . continued footnote . . .]

non-precedential, not properly citable disposition. 9th Cir. Local Rule 36-3. And *Yeager* merely ruled that the statute of limitations barred the Lanham Act claim in that case because suit was filed more than three years after plaintiff knew or should have known of his claim. *Yeager, supra*, at *3. Neither discusses the policy differences or authorities cited above, nor disputes that Lanham Act claims do not accrue until a plaintiff knows or has reason to know of them.

speech because the game is. EA's argument fallaciously assumes what it must prove.

Sixth, EA's argument that its intentionally ineffective scrambling is only "implicitly" misleading (AB-33-34) misconstrues the word "explicit." Although not clearly defined in the "balancing test" case law, "explicit" means "fully revealed or expressed without vagueness ... or ambiguity." Merriam-Webster Online Dictionary, www.merriam-webster.com/dictionary/explicit; *see also*, AB-37.

Here, there are sufficient facts from which a jury could conclude that there was nothing "vague" or "ambiguous" about EA's use of Brown's persona, or about EA's decision to conceal its misconduct by ineffectively "scrambling" Brown's persona in its game after being warned to conceal its actions by the NFLPA. A jury also could reasonably conclude that there was nothing "vague" or "ambiguous" about EA's continuing use of Brown's persona after its scrambling, or in EA's public representations that it licensed the use of those portrayed in its game, or in its denials to Brown's representatives that Brown appeared in its game. Although EA's taking and use of Brown's entire professional career alone should be sufficient to create an issue of fact as to whether EA's misconduct was "explicitly misleading" because of differing perceptions about use within, as

opposed to in the title of, its game, these significant additional facts create further factual disputes that should have precluded the granting of a motion to dismiss.⁶

II. OTHER POTENTIALLY APPLICABLE STANDARDS FAVOR REVERSAL

A. Whether The “Balancing” Test Applies Here Depends On The Factual Context

EA’s flat assertion that “there is no doubt that *Rogers* provides the controlling test” in this action (AB-2) fails to withstand scrutiny.

This Court has applied three other tests to address Lanham Act/First Amendment concerns in various factual settings. (AOB-26, 41-45.) This Court must have found that the different facts of those decisions supported the different legal standards that it applied, since one panel of this Court cannot overrule another. *Hulteen v. AT&T Corp.*, 498 F.3d 1001, 1009-10 (9th Cir. 2007). Thus, this Court should carefully examine the facts of this case to determine which of the various legal standards it has previously articulated should apply here. Such a fact-

⁶ EA’s related argument that its misconduct is merely “implicit” because the public must use logic to recognize who Jim Brown is (AB-33) fails to withstand scrutiny. Apparently, in EA’s view only directly naming Brown would count as explicitly identifying him; so that if EA said only that “the game includes the Cleveland Browns’ greatest running back,” that would only be an implicit identification and thus legally permissible. That argument must fail, and at least raises a factual question about whether EA sufficiently identified Brown to explicitly mislead the public.

intensive inquiry should not properly be resolved on a motion to dismiss, and at least creates “doubt” about the legal standard that this Court should apply here.

In particular, the facts of Brown’s case are unlike those in *ESS*, which EA and the district court used as guiding precedent. *ESS* was the first case in this Circuit to expand the “balancing” test to certain uses within the body of a work, as opposed to a work’s title, but it did so *only* in a context where that use was incidental yet artistically related to the work. *ESS* repeatedly underscores the limited nature of its holding by emphasizing the incidental nature of defendant’s use of plaintiff’s “strip club” mark in the background of the videogame at issue, noting that “[t]he game does not revolve around running or patronizing a strip club,” and that “[t]he chance to attend a virtual strip club is unambiguously *not* the main selling point of the game.” *ESS*, 547 F.3d at 1100, 1101. Earlier “title” balancing cases arguably involved more significant uses than *ESS*, but like *ESS* involved more limited takings of a single name or static image of the mark. *See, e.g., Mattel v. MCA, supra* (use of mark in song title); *ETW Corp. v. Jireh Publ’g.*, 332 F.3d 915 (6th Cir. 2003) (use of single image in “artistic” poster).

Here, in contrast, EA did not merely take Brown’s name, a single static image, or some other isolated aspect of his persona and use it in an incidental way. Instead, EA sought to digitally recreate his entire professional career, including everything that made Brown the phenomenal football player that he was. The

Supreme Court has described such misappropriation of one's "entire act" as the most significant taking of an individual's intellectual property rights possible in the analogous right of publicity setting, as by its conduct EA sought to profit from "the very activity by which the entertainer [i.e., retired football player] acquired his reputation in the first place." *Zacchini v. Scripps-Howard, Inc.*, 433 U.S. 562, 573 (1977).

A taking this significant supports a Lanham Act claim against a First Amendment defense, as the Supreme Court has twice affirmed in analogous settings. *See Zacchini, supra*; *see also SFAA v. USOC*, 483 U.S. 522, 541 (1987) (Supreme Court rejects a First Amendment defense to a trademark infringement claim involving the statutory "Olympic" mark). (*See also* AOB 27-41.) It is notable that the First Amendment speaker in *Zacchini* was a news broadcaster, much closer to the core of the First Amendment than a non-expressive video football game.

Balancing is not the appropriate test to use here for these reasons. Instead, this Court should reverse the district court's dismissal under either of the other two following standards that are potentially applicable here.

B. The “Likelihood Of Confusion” Standard Favors Reversal

EA argues that this Court should not apply the “likelihood of confusion” standard because it “rejected” that test in *Mattel v. MCA*, *supra*. (AB-17.) That argument lacks merit because it misconstrues what *Mattel* could and did do.

EA’s claim that *Mattel* “rejected” this Court’s ruling in *Dr. Seuss Enterprises v. Penguin Books USA*, 109 F.3d 1394 (9th Cir. 1997), mistakenly assumes that one panel decision can overrule another. Of course, it cannot; only an *en banc* decision can do that.

Mattel itself confirms that it was factually distinguishing, rather than overruling, *Dr. Seuss*. *Mattel* was careful to distinguish its facts from those in *Dr. Seuss*, noting that in *Dr. Seuss* (as opposed to *Mattel*), defendants made use of plaintiff’s mark within the body of a book as part of a failed attempt at parody. *Mattel*, 296 F.3d at 894, 901-2; cf. *Dr. Seuss*, 109 F.3d at 1400-02.

The facts of Brown’s case are closer to the facts of *Dr. Seuss* than they are to either *Mattel* or *ESS*. Here, as in *Dr. Seuss* (but different from *Mattel*), EA used Brown’s persona within the body of its game. Here, as in *Dr. Seuss* (but different from *Mattel*), the use was not parodic. Here, as in *Dr. Seuss* (but different from *Mattel*), the use was not meant to make any critical or other comment about Brown. Here, as in *Dr. Seuss*, EA’s taking was much more extensive than the incidental, limited taking in *Mattel* or *ESS*. The likelihood of confusion standard

articulated in *Dr. Seuss* should apply here and, in light of factual disputes concerning the confusing nature of EA's game, that issue should not have been decided on a motion to dismiss.

C. The “Alternative Means” Standard Favors Reversal

EA argues that the “alternative means” test should not apply here because (1) *Rogers* and other out-of-circuit decisions have stated that it insufficiently protects First Amendment rights, and (2) the facts here are supposedly distinguishable from those in *International Olympics Committee (“IOC”) v. San Francisco Arts & Athletics (“SFAA”)*, 781 F.2d 733 (9th Cir. 1986), in which this Court applied the “alternative means” test. (AB-18-21.) Again, these arguments fail.

Other courts' characterizations of the alternative means test as “insufficiently protective” of First Amendment rights are policy statements rather than legal arguments. While the policy issues involved are difficult, policy views should not substitute for Constitutional jurisprudence already established by this Court and the Supreme Court.

This Court has conspicuously *not* held that the alternative means test is insufficiently protective of First Amendment rights. To the contrary, it applied the alternative means test to reject a First Amendment defense to a trademark infringement claim involving the statutory “Olympic” trademark. *IOC v. SFAA*,

supra. That decision has the distinction of being the only one of this Court's "trademark/speech" cases to have been considered and affirmed by the Supreme Court. *SFAA v. USOC*, 483 U.S. 522 (1987).

The Supreme Court's affirmance of *IOC* did not expressly adopt the "alternate means" test, but it applied legal standards consistent with *IOC*'s principles. The Supreme Court in *SFAA*, like this Court in *IOC*, rejected arguments that use of the statutory "Olympic" mark in the title "Gay Olympic Games" was protected by the First Amendment because it was non-confusing political speech. 483 U.S. at 528, 535. The Supreme Court's holding did not dispute that some of *SFAA*'s speech was "political," 483 U.S. at 535-36, but echoing the reasoning of this Court, combined its "time, place and manner" case law that regulates use of others' real property to engage in speech with its "commercial speech" case law and applied them "together" to evaluate the trademark infringement claim before it. *SFAA*, 483 U.S. at 536, n.16.

Applying those cases, the Supreme Court stated that the Olympic Trademark Act "restricts only the manner in which the SFAA may convey its message," and determined that "[t]he appropriate inquiry is thus whether the incidental restrictions on First Amendment Freedom are greater than necessary to further a substantial governmental interest." *SFAA*, 483 U.S. at 536-37.

Concluding that the restrictions on SFAA's political speech were not greater than needed to protect the USOC's trademark interests, the Supreme Court stated:

The SFAA's expressive use of the word [Olympic] cannot be divorced from the value USOC's efforts have given to it. The mere fact that SFAA claims an expressive, as opposed to a purely commercial purpose does not give it a First Amendment right to appropriate to itself the harvest to those who have sown ... the USOC's right to prohibit use of the word "Olympic" in the promotion of the athletic events is at the core of its legitimate property interest. 483 U.S. at 541 (internal quotations and citations omitted).

The Supreme Court's affirmance thus recognized that this Court in *IOC* struck the proper "balance" in reconciling competing constitutional interests in the factual setting before it.

EA's attempt to distinguish *IOC* by arguing that it involved a special statutory "Olympic" trademark that lacked statutory defenses rather than a regular Lanham Act trademark that possesses them (AB-20) is illogical and confuses Congressional intent with Constitutional requirements. Both the Olympic Act mark at issue in *IOC* and *SFAA* and the Lanham Act mark at issue here involve Congressional legislation that regulates unauthorized uses of trademarks by third parties. Congress arguably sought to restrict more "speech" in the Olympic Trademark Act than it did in the Lanham Act, as the Olympic Act more broadly regulates unauthorized use of the "Olympic" mark by prohibiting even non-

confusing uses of the mark, and making various Lanham Act defenses inapplicable to the Olympic mark.⁷ *See IOC v. SFAA*, 789 F.2d 1319, 1322-23 (9th Cir. 1986) (dissenting from denial of petition for rehearing *en banc* of this Court’s *IOC* decision because the panel decision approved a regulation on speech “unrestrained by the need to show likelihood of confusion or to overcome Lanham Act defenses”).

In contrast, the Lanham Act at issue here provides *more* First Amendment protection than the Olympic Act at issue in *SFAA* provided, because the Lanham Act regulates only misleading uses of marks, and has statutory “fair use” and other defenses that statutorily accommodate First Amendment concerns. The Supreme Court in *SFAA* thus held that the broader regulation of speech embodied in the Olympic Act sufficiently protected speech rights. Such a constitutional standard necessarily accommodates the lesser regulation of speech present in this Lanham Act case, regardless whether Congress intended to regulate more speech in the Olympic Act than in the Lanham Act.

Brown’s case is closer to *IOC* than to *ESS*, and thus *IOC* should govern this action. In the case at bar, however, as in *IOC*, defendants claim to be engaging in

⁷ EA’s related argument that the Olympic Act applies “primarily to commercial speech” (AB-20) is accurate but irrelevant, as the Lanham Act *also* applies “primarily to commercial speech.” The difference is that the Lanham Act does so in a way that is more protective of speech interests than the Olympic Act does.

“core” First Amendment expression, namely political speech in *IOC* and artistic expression here. Here, as in *IOC*, the taking and use was not “incidental” as it was in *ESS*, but instead involved a taking and use “at the core” of USOC’s and Brown’s legitimate property interests. Here, as in *IOC*, EA’s allegedly “expressive use” of Brown’s persona “cannot be divorced from the value” Brown’s years of effort in an extraordinary professional career have given it. *SFAA*, 483 U.S. at 541. Here, as in *IOC*, the mere fact that EA “claims an expressive, as opposed to a purely commercial purpose does not give it a First Amendment right to appropriate to itself the harvest of those who have sown.” *Id.* This Court should apply the “alternative means” test and reverse the district court’s dismissal.

D. The Cases Brown Cites Support Reversal Of The Dismissal

EA makes various arguments that the cases Brown cites establishing and discussing Brown’s Lanham Act rights are “irrelevant” because they involve “commercial speech” or “advertising.” (AB-14-17.) Those arguments lack merit.

EA’s mischaracterization of Brown’s position as “radical” is invalid. It is not “radical” to ask this Court to consider the facts presented in Brown’s complaint and accompanying evidence to evaluate the district court’s motion to dismiss; to argue that factual disputes should have precluded a grant of EA’s motion to dismiss; or to ask this Court to apply its own case law, and Supreme Court authority, to the facts of this case.

Further, Brown has *not* ignored “the fundamental rule that content-based restrictions on non-commercial speech trigger substantial First Amendment scrutiny” (AB-14), though such a general statement does little to illuminate the issues presented. That general rule was articulated in “speech” cases that were uncomplicated by competing intellectual property interests, *see Glendale Associates v. NLRB*, 347 F.3d 1145, 1156 (9th Cir. 2003), and hence its application in the intellectual property setting is, at best, limited. The Supreme Court and this Court have articulated different approaches for addressing these issues in the intellectual property setting, and Brown has focused on those approaches.

However, to use the terminology EA invokes, Brown argues that the legal standards developed by this Court and the Supreme Court constitute, at most, a content-*neutral* regulation of speech. Trademark law regulates misleading use of marks regardless of the content of the “speech” by which a defendant infringes trademark rights. *See SFAA, supra*.

EA’s argument that its videogames can never be considered commercial speech because they are “expressive works” (AB-14-15) is inaccurate, irrelevant, and confuses the medium with the message. EA’s games in fact communicate no expressive “message,” but instead seek to digitally recreate, as realistically as possible, an actual NFL football game. While games with story lines or other expressive elements can qualify as “speech,” mere game simulations have been

characterized as unprotected by the First Amendment. *See American Amusement Machine Ass’n v. Kendrick*, 244 F.3d 572, 580 (7th Cir. 2001) (restricting videogames that “lacked any story line and were merely animated shooting galleries” might well “survive a constitutional challenge”); *Wilson v. Midway Games, Inc.*, 198 F. Supp. 2d 167, 180-81 (D. Conn. 2002) (“videogames that are merely digitized pinball machines are not protected speech”); *America’s Best Family Showplace Corp. v. City of New York*, 536 F. Supp. 170, 173-74 (E.D.N.Y. 1982) (“a videogame, like ... a game of baseball is pure entertainment with no informational element”); Michael T. Morley, Comment, “ ‘Exceedingly Vexed and Difficult’: Games And The First Amendment,” 112 Yale L.J. 361 (2002) (“games in general are not sufficiently imbued with elements of communication to fall within the scope of the First and Fourteenth Amendments” [italics deleted]).

Further, even if EA’s game were deemed an expressive medium, this and other courts have ruled that “expressive” media can contain “commercial speech” in the false endorsement setting because of the commercial messages they convey. *See Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1000, 1002 (9th Cir. 2001) (use of plaintiff’s photograph in a “quarterly” publication that included information about surfing and products was commercial speech that would not bar a Lanham Act false endorsement claim); *Facenda v. NFL Films*, 542 F.3d 1007, 1015-18 (3d Cir. 2008) (use of 13 seconds of audio of “voice of God” narrator in half-hour

“Making of *Madden NFL*” video “commercial speech” that would not bar a Lanham Act false endorsement claim); *Dryer*, 689 F. Supp. 2d at 1116-21 (NFL players’ Lanham Act false endorsement claim survived because NFL Films’ use of players’ names and likenesses in “History” series of “documentary” videos could be “commercial speech” primarily intended to promote NFL Football); *see also*, *Hart v. EA*, *supra* (EA’s motion to dismiss right of publicity claim involving alleged use of football’s player’s image in EA videogame denied because of factual disputes about whether the videogame constituted commercial speech). EA’s use of a retired football player’s persona in *Madden NFL* could constitute commercial speech, because, like the “documentary” videos at issue in *Dryer* or the EA videogame in *Hart*, the works are ultimately intended to promote NFL football.⁸

EA’s argument that Brown’s citation to this Court’s false endorsement case law is “misplaced” mischaracterizes why Brown cited those cases. Those cases establish how this Court has defined the Lanham Act rights at issue here. Brown

⁸ Since this Court in *IOC* applied a standard that the Supreme Court affirmed by analogizing to “commercial speech” case law, *see SFAA*, 483 U.S. at 536, n.16, Brown asks this Court to apply that standard, without conceding the “commercial speech” question. If deemed misleading commercial speech, then EA’s game receives no First Amendment protection. *Bolger v. Young’s Products Corp.*, 463 U.S. 60, 68 (1983).

possesses the rights they articulate under the law of this Circuit. Those rights exist independent of any defense claimed by EA.

EA, in contrast, in effect argues that mere invocation of a First Amendment defense automatically extinguishes, and thus makes “irrelevant,” the rights established by this Court’s Lanham Act case law. Such reasoning is contrary to all of this Court’s decisions.

CONCLUSION

The district court’s dismissal of Brown’s Lanham Act and state law claims should be reversed so that a sufficient record can be made on which a reasoned decision on these complex issues can be rendered.

Dated: December 20, 2010

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NOTICE OF RELATED CASE

The appeal in *Keller v. Electronic Arts, Inc.* (9th Cir. No. 10-15387), is “related” to this appeal. Pursuant to this Court’s order of April 30, 2010, to the extent practicable, the *Keller* appeal and this appeal will be assigned to the same panel.

CERTIFICATE OF COMPLIANCE

I certify that this brief complies with the type-volume limitation of the Federal Rule of Appellate Procedure 32(a)(7)(B) and contains **6,808** words, exclusive of the corporate disclosure statement, the table of contents, table of citations, any addendums, and any certificates of counsel, as counted by the 2003 Microsoft Word word-processing program used to generate this brief.

I certify that this brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule Appellate Procedure 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using 2003 Microsoft Word word-processing program with a 14-point Times New Roman font.

Dated: December 20, 2010

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CERTIFICATE OF SERVICE

Brown v. Electronic Arts, 9th Cir. No. 09-56675

APPELLANT'S REPLY BRIEF

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeal for the Ninth Circuit by using the appellate CM/ECF system on December 20, 2010.

I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

s/Bess Hubbard

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